

REMARKS/ARGUMENTS

No claims are amended, canceled, or added by this paper. Claims 1-23, 41-42, 44, and 67-76 stand allowed. Claims 24-40, 43, 45, 46-66, and 77 stand rejected. Applicant respectfully requests favorable reconsideration of this application view of the following remarks.

Rejection Under 35 U.S.C § 251

The sole remaining rejection in the application is the rejection of claims 24-40, 43, 45, 46-66, and 77 under 35 U.S.C. § 251 as allegedly attempting to recapture subject matter surrendered in the application to obtain the original patent, 5,657,600. This Office Action does not comply with a directive issued over four years ago by the Board of Patent Appeals and Interferences (BPAI), and Applicant respectfully traverses the rejection for the following reasons:

A. The Office Action does not comply with a prior BPAI remand.

The recapture rule has been an issue for much of the eight year prosecution of this application, and in fact was the subject of an appeal. In that appeal, BPAI remanded the application “to the examiner for a determination of whether the rejection under 35 U.S.C. § 251 remains appropriate in view of Ex parte Eggert.” (BPAI remand, May 13, 2004). The ensuing prosecution history, spanning well over four years, does not reveal that any such determination has been performed.

The BPAI remand offered the Examiner two alternatives:

1) if “the examiner determines that the rejection under 35 U.S.C. § 251 remains appropriate, the examiner is authorized to prepare a supplemental examiner’s answer specifically addressing the 251 rejection,” or

2) if “the examiner determines that the rejection under 35 U.S.C. § 251 is no longer appropriate, the examiner should withdraw the rejection in an appropriate Office action.”

The pending Office Action, the first written substantive action since the BPAI remand, does neither of these, but simply makes a conclusory rejection that does not comply with Rule 104 as discussed subsequently.

The BPAI also stated that “[t]his application, by virtue of its ‘special’ status, requires **immediate action**....” (Id., emphasis added). The piecemeal prosecution of this application hardly comports with this directive for “immediate action,” and has cost Applicant a considerable portion of the term of the patent that should issue from this application. In the more than four years since the BPAI decision in May, 2004, the Office requested various claim changes to place the application in condition for allowance. A supplemental declaration was also requested. Not once was recapture raised until the unsupported, conclusory rejection in the October 7, 2008 Office Action was made.

B. Applicant traverses the rejection.

Turning to the merits of the rejection, Applicant respectfully traverses it on multiple grounds.

It appears that *Ex parte Eggert* (67 USPQ2d 1716 (BPAI 2003)) is no longer good law. However, its application would have been inapposite, because *Ex parte Eggert* is concerned with determining the range of subject matter that is surrendered when a claim is amended during the prosecution of the original patent. As is explained in more detail below, no claims relating to the subject matter of the claims in the present application were amended in the prosecution of the original patent. The question addressed by *Ex parte Eggert* does not even arise in the present application.

Furthermore, the rejection is improper under more current recapture case law. The Court of Appeals for the Federal Circuit has articulated a three-step process for applying the recapture rule:

The first step is to determine whether and in what aspect the reissue claims are broader than the patent claims. The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter. Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule.

Kim v. ConAgra Foods, Inc., 80 USPQ2d 1495, 1501 (Fed. Cir. 2006), citing *Pannu v. Storz Instruments, Inc.*, 59, USPQ2d 1597 (Fed. Cir. 2001). The Office Action clearly does not

present a *prima facie* case of recapture, and application of the above law shows that Applicant's claims do not violate the recapture rule under binding Federal Circuit law.

i. *The Office Action does not indicate how the claims are alleged to be broadened.*

Regarding the first part of the recapture test, the Office Action does not explain how the claims are alleged to be broader than those of the '600 patent, and thus no *prima facie* case is presented. The rejection merely states the conclusion that "the claims failed to avoid the recapture rule because they had been broadened to include surrendered subject matter but had not been narrowed in any material respect," and offers a definition of what it means for a claim to be "materially narrowed." (Office Action p. 2). The Office Action is a mere statement of the law, without any application of the law to the facts of the application. This conclusory rejection also does not comply with 37 C.F.R. § 1.104(b), which requires that an examiner's action be "complete as to all matters," and does not provide any rationale to which Applicant can respond.

ii. *The Office Action does not identify what subject matter was allegedly surrendered.*

Regarding the second part of the recapture test, "[i]t is clear that in determining whether 'surrender' of subject matter has occurred, the proper inquiry is whether an objective observer viewing the prosecution history would conclude that the purpose of the patentee's amendment or argument was to overcome prior art and secure the patent." *Kim, at 1502*. See also *North American Container, Inc. v. Plastipak Packaging, Inc.*, 75 USPQ2d 1545, 1557 (Fed. Cir. 2005), requiring that, in order for the recapture rule to be violated, "the broader aspect of the reissue claims relates to subject matter that was surrendered during prosecution of the original-filed claims."

Claims 1-16 of issued patent 5,657,600 were never amended during the prosecution of the application that resulted in that patent, and these claims were never rejected under 35 U.S.C. § 102 or § 103. A rejection on the ground of non-statutory obviousness-type double patenting was traversed. Some other claims directed to the embodiments shown in Figures 11-16 were rejected under 35 U.S.C. § 103(a) and subsequently canceled, but the

limitations at issue in that rejection were unrelated to any of the claims rejected in the present application.

The Office Action does not point to any amendment or argument in the prosecution of the original patent as allegedly surrendering subject matter encompassed by the presently pending claims. However, as is explained below, because the claims at issue have been materially narrowed, the recapture rule may be avoided.

iii. *The claims at issue have been materially narrowed.*

Under the third part of the recapture test, the recapture rule may be avoided if the claims have been materially narrowed in other respects. The Office Action states that a claim is considered to be materially narrowed and thus avoids the recapture rule when limited to aspects of the invention: (1) which have not been claimed and thus were overlooked during prosecution of the original patent application; and (2) which patentably distinguish over the prior art. (Office Action p. 2). The Office Action does not apply this test to the present application, but such an analysis reveals that the claims have been materially narrowed, and recapture should not apply.

The only rejection in the pending application is for the alleged violation of the recapture rule. There is no prior art rejection. The second part of the above test is accordingly met. That is, there is no issue as to whether the rejected claims patentably distinguish over the prior art.

In addition, the first part of the test is met as each of the rejected independent claims includes at least one new material limitation not claimed before.

Claim 24 retains all of the limitations necessary for patentability of original patent claim 13, and adds a new material limitation requiring *a supporting shelf*.

Claim 43 also recites *a supporting shelf*, and requires that *a portion of said outer surface of said first panel extends at an obtuse angle with respect to the bottom portion*. In addition, claim 43 includes new limitations reciting *at least two partitions extending from said inner surface of said first panel to form cavities integral with said space, each partition comprising a bridging member extending between and connecting said panels*.

Claim 45 recites an *insulated wall formed from a pourable building material*. The wall includes two building components, one of which is similar to that of original claim 13, and also specifies a wall with a particular dimension *formed by building material* in the building components. The insulated wall also includes *a finger formed by building material received in said cavity, said finger defining with said third panel a supporting shelf, and said shelf being integral with said wall*.

Claim 46 is substantially similar to original claim 13, but further defines a *first width* and a *second width*, and *said second width being greater than said first width to define a supporting shelf*.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

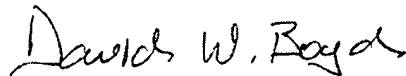
If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned representative David W. Boyd at 303-571-4000.

Appl. No. 09/374,598
Amdt. dated March 10, 2009
Reply to Office Action of October 7, 2008

PATENT
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The Commissioner is authorized to charge any fees due or credit any overpayment to the deposit account of Townsend and Townsend and Crew LLP, Deposit Account No. 20-1430.

Respectfully submitted,



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